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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572

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EXAMINER	
LE, KHANH H	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,732	IWAYAMA ET AL.	
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the correspondence dated 11/21/2005.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/2005 has been entered. Claims 1-12 were pending. New claims 13-15 are added. Claims 1, 2, 9, 10, 11, 12, 14-15 are independent.

Specification

3. The abstract of the disclosure is objected to because the abstract must be 150 words or less. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9 and 13 are rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter.

Claim 9 is directed to a "program" i.e. software per se. In order to overcome this rejections, the claim should recite at least a computer readable medium. *

New claim 13 fails under this section because the claimed invention is so broad (involving only storing information as a positive step) that no practical application , as required under this section, can be ascertained from the claim.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-8, 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 claims:
(For ease of discussion, letters a) to i) are added to each step)

An advertising method for broadcasting advertisements to user-operated, network-interconnected computers including a first computer operated by a first user and a second computer operated by a second user, the method including:
a) a status administration step of administrating status of users including the first user and the second user;
b) a status broadcast step of receiving from the first computer and broadcasting to the second computer the status of the first user;
c) a memory step of correlatively recording in an advertising database resource identification information specifying a resource on the network with advertising information including image data for the advertisements;
d) an advertising acceptance step of **accepting from said computers** at least one selected

from **the resource identification information and the advertising information to be recorded by said memory step;**

e) a storing step of storing in **said advertising database information** received in said advertising acceptance step,

f) a resource detection step of detecting resource identification information for a first resource in use by the first user;

g) an extraction step of extracting from the advertising information recorded in said memory step first advertising information corresponding to the resource identification information for the first resource, detected in said detection step;

h) a broadcast step of broadcasting to the second computer said first advertising information extracted in said extraction step; and

i) an advertising step for displaying as status of the first user on the second computer **advertising image data included in said first advertising information** broadcast in said broadcast step.

The confusing phrases are set out in bold.

As to step d), as drafted, it is not clear how the system can accept from **" said computers" (i.e. 1st user and 2nd user computers")** ... **"one selected from the resource identification information and the advertising information to be recorded by said memory step" :** it is not clear how the user computers access the database of the resource identification information and the advertising information. It is not clear why the resource identification information and the advertising information are to be recorded by said memory step since they apparently are already recorded thereon in step c). Does that mean another recording step after the acceptance steep is done? (It seems there is as step e) states "a storing step of storing in **said advertising database information** received in said advertising acceptance step". However , **"said advertising database information"** in step e) lacks antecedent basis. No "advertising database information" was mentioned before.)

Further as to step d) again, it is not clear from which computer the advertising information is selected , what is being done with it after it is accepted, and whether and on which

database it is recorded. Appropriate correction is required as substantial uncertainty as to the scope of the claim is involved.

(In prior and in the instant Office Actions, for art application purposes, claims 1, 9,10, 12 had been and are interpreted as involving the following steps and means to carry out them including:

- interconnection of the 1st and 2nd users,
- the 2nd user checking on status of 1st user,
- a database of ads correlated to some content URL's
- detecting URL's used by the 1st user
- extracting ads corresponding to URL's used by 1st user

(all above are admitted art. Specifications pages 2-3).

and the step of sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user")

Claim 13:

AS mentioned above under 35 USC 101 section, this claim involves only storing as a positive step, thus it is unclear how the broadcasting ads mentioned in the preamble is performed. Appropriate correction is required.

Claim 14:

It is unclear what "to have access to a status of said first computer " in the phrase "thereby allowing a second computer to have access to a status of said first computer " means when later in the claim it is claimed that the 2nd computer is to receive the "extracted advertising information as status of said first computer". In other words is the access to a status of the first computer intended to be recited as a positive step? It is interpreted here that is not, and that that phrase is redundant and only means, as claimed later in the claim, that the 2nd computer is to receive the "extracted advertising information as status of said first computer". Appropriate correction/clarification is required.

Claim 15. It is unclear what " extracting **as** a distribution destination information **pertaining to**... one other user" means . Does this mean extracting a distribution list made up to those at least one other users? The specific confusing terms that render the phrase unclear are in bold. Further in the distributing step, are both "distribution destination" (s) the same as "distribution destination information"? Further "user's" in "user's in said distribution destination" should be "the at least one other user" for proper antecedent basis. Appropriate correction is required.

Other Interpretation

8. Claim 3 at page 54 is interpreted as follows: the owners of the ads, registered or not, and their addresses, need to be asked for their permission to correlate ads to content URL's .

Claim 4 : from "said advertising acceptance means... with the unregistered advertising information" , it is interpreted that detailed information is correlated to some ads .

Response to Arguments

9. Applicant's arguments have been fully considered but they are not persuasive. Contrary to arguments at page 9, 1st-3rd full paragraph: even if LiQ only teaches that product or ad information are shown in later pages as argued (" a few clicks away " i.e. following the first notification page as argued) but nothing in the claims exclude the product or ad information from coming from later pages , thus LiQ does not teach away as argued.

For example claim 1 only claims in the last step " an advertising step for displaying as status of the first user on the second computer **advertising image data included in said first**

advertising information broadcast in said broadcast step". This does not exclude the product or ad information from coming from later pages, as (at least) disclosed by LiQ.

As to Applicants' argument at page 9 5th full paragraph, that paging users into a chartroom is not providing them with product information, Applicant's representative contradicts himself when on page 10 ,he admits that LiQ discloses "a few clicks later .. they can view a wide variety of products.."

The claims again do not claim the ad image data has to be displayed on one page or the first page as Applicant's representative seem to argue , at page 10 , 1st paragraph, when noting that LiQ's "page" does not have "additional information". Further the "as status of the first user " limitation is directed to the intent of the message not to any positively recited action which is just sending the ad to the 2nd user thus does not have patentable weight.

Thus the previous rejections are maintained and the following is a repeat of the last Office Action with minor modifications to address the new claims 13-15.

In LiQ, certainly the product information sent to the 2nd user to view together with the first user is advertising information which includes advertising image data. Further, in LiQ, the second user getting a page (to shop together) implicitly receives a status of the first user, i.e. that the first user is online at the time. Therefore, the LiQ page reads on displaying, on the second computer, advertising data image included in said first advertising information broadcast in said broadcast step, as status of the first user (the last step of claim 1).

At page 9 of the amendment, second full paragraph, Applicants point out an example that would read on the last step of claim one: an ad icon entitled "virtual shopping Mall A" displayed to second user (user A) serves to inform user A that user B is online and is visiting a web page relating to the ad material. Thus Applicants agree that the status of the first user, can be implicitly relayed, via an ad icon entitled "virtual shopping Mall A. LiQ is doing the same type of implicit relaying of the first user status by displaying a page for together shopping to the second user. Thus LiQ's page serves as implicitly "displaying a user status".

Further, the arguments at page 10 attacking the combination with Goldhaber are equally unpersuasive, as legally-sufficient motivation to combine the references was presented on page 6 of the last Office Action.

It is further noted that all officially-noted facts, presented earlier, and not seasonally or properly challenged are taken as admitted. MPEP 2144.03.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-4 9,10, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ, Inc. Makes Gift-Giving Easier with Online-paging. Shop and Chat Technology lets Consumers make decisions Together , Business Wire, Dec. 21, 1999, herein LiQ-Paging, in view of DIALOG(R)File 640, record # 10719046, BIG BUDDY IS WATCHING YOU. San Francisco Chronicle (SF) - SUNDAY, August 6, 2000 By: Cheryll Aimee Barron, herein Barron.

As to claim 1, 9,10, 12, 14 all steps, (and implicit computer programs/devices), except the step of sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user" such as

- interconnection of the 1st and 2nd users,
- the 2nd user checking on status of 1st user,
- a database of ads correlated to some content URL's
- detecting URL's used by the 1st user
- extracting ads corresponding to URL's used by 1st user

are admitted art (see at least Specifications pages 2-3).

As to sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user", a "status" message is any message.

LiQ-Paging discloses shopping buddies logged on at LiQ.com are paged privately when their buddies are shopping and invited to join into private chatrooms to see products for together shopping. Thus the 2nd user of the LiQ system implicitly gets a message about the status of a first user, about a content being a page viewed by the first user.

Further Barron discloses an instant message system and software where someone notes when a page was viewed by a buddy on line and sends comments. Thus Barron teaches that the 2nd user is notified of the particular page viewed by the first user.

It would have been obvious to one skilled in the art at the time the invention was made to add Big Buddy to LiQ-Paging to allow the 2nd user to view the page viewed by the first user for together shopping as taught by LiQ-Paging.

Further it is well-known at invention time that many ads are associated with each product/service/information webpage for cross- or up-selling purposes. Therefore it would have been obvious to one skilled in the art at the time the invention was made to send an ad associated with the page viewed to the first user to the second user as well to effect cross- or up-selling to the second user as well.

As to claims 2-4, Official Notice is taken that the following facts are well-known:

accepting ads from advertisers, correlating them to certain content URL's with their permission and communicating with the advertisers (ad owners) using their addresses are obvious and well-known business methods.

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these methods to the system of LiQ-Page/ Barron above effect the system of LiQ-Page/ Barron according to well-accepted business methods.

As to claim 13, as stated above

- interconnection of the 1st and 2nd users,
- the 2nd user checking on status of 1st user,
- a database of ads correlated to some content URL's
- detecting URL's used by the 1st user
- extracting ads corresponding to URL's used by 1st user

are admitted art (see at least Specifications pages 2-3. The admitted art does not specifically disclose storing 1st and 2nd user information but Official Notice is taken that it is well-known to record and store at least correlating user identification information when these use any online systems in order for the system to service those users thus it would have been obvious to one skilled in the art at the time the invention was made to add such information to the above admitted art for that advantage. Further systems for 2nd users checking on status of 1st users are admitted thus 2nd users 'desirous of subscribing" to 1st users statuses is implicitly admitted.

Claim 15. It is interpreted " extracting **as** a distribution destination information **pertaining to**... one other user" means . means extracting a distribution list made up to those at least one other users? . Further in the distributing step, are both "distribution destination" (s) the same as "distribution destination information"? Further "user's" in "user's in said distribution destination" should be "the at least one other user" for proper antecedent basis. Appropriate correction is required.

The above admitted art and LiQ in combination with Barron and the Official Notices and Motivations as stated in the discussion of claims 1, 9,10, 12, 14 applies here as well. Thus LiQ in combination with Barron and the Official Notices and Motivations as stated in the discussion above disclose sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user".

This combination of Admitted art/LiQ /Barron and Official Notices above, does not specifically disclose one user registering the other as buddy . However at least LiQ discloses buddy , family and friends for together shopping systems. It would have been obvious to one skilled in the art at the time the invention was made to add linking one buddy to another and store such linkage in a database as conventionally done, so the system would know who's buddy to whom, and provide notifications to the appropriate persons to effect together shopping as discussed in LiQ. It would have been further obvious for at least one user in the buddy group to register at least another buddy (e.g. a first user as claimed) to effect such linkage. Thus when a LiQ buddy is notified of the status of another (first user) buddy, it would have been obvious such linkage of buddies would have been extracted from a database where it was stored and the corresponding buddy to be notified would have been the " extracted (from the database) distribution destination" as claimed, in order to provide together shopping as discussed in LiQ. As discussed above, ads would have been obvious to be added to any shopping session thus the buddy (the " extracted (from the database) distribution destination") would have been distributed the ad as status of the first user as claimed.

12. Claims 5-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ-Paging and Barron as applied to claim 4 above, and further in view of Goldhaber et al., US 5,794,210.

As to claim 5-8,

the steps of a user requesting detailed information associated with the ad sent, returning the detailed information if available, monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3).

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of LiQ-Page/ Barron to effect the ad compensation/ charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

Claim 11 is interpreted as a combination of claims 1-8 wherein the incentives are given to for the 2nd (consulting) user. It would have been obvious to one skilled in the art at the time the invention was made , in view of the LiQ-Page/ Barron system of connected sopping together users and in view of Goldhaber's compensation scheme, to add rewarding the consulting user to the LiQ-Page/ Barron system , to encourage ads can be viewing as taught by Goldhaber.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The

Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 6, 2006

KHL

KHL

RETTA YEHDEGA
PRIMARY EXAMINER